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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/971,903
Filing Date: November 17, 1997
Appellant(s): HARUKI ET AL.

Richard A. Gollhofer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 19, 2005.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Grounds of Rejection to be Reviewed*

The Grounds of Rejection to be Reviewed contained in the brief is correct.

(6) *Grouping of Claims*

(7) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Prior Art of Record*

5,867,714	TODD et al	2-1999
5,845,077	FAWCETT	12-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

(a) Claims 1-6, 8, and 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd et al (5,867,714) in view of Fawcett (5,845,077).

Claims 1, 10-13, 16, and 17: Todd discloses a system and method for registering and updating software on a remote computer, comprising:

a. User information general management means managing user registration information and status information by managing product information data and providing new or updated information in accordance with a request from a user (col 13, lines 45-49 and col 14, lines 25-35);

b. User registration/reference means for notifying the general management means of the user registration and status information and for requesting new information about the product (col 12, lines 30-65);

c. Extracting information about the new or updated product from one of the remote databases and transmitting the information to the user in response to receiving the user registration and status information (col 13, lines 16-28 and col 14, lines 25-35);

Todd further discloses tracking usage data (i.e. number of uses) and using the data to provide targeted suggestions/offers to the user (col 4, lines 31-41 and col 12, lines 30-65). Since these suggestions/offers are based on the type of information requested by the user during the registration step above, it is inherent that the targeted

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suggestions/offers are from vendors which sell products that may be of interest to the user.

While Todd explicitly discloses that the vendor receiving this information is the vendor (manufacturer) of the software product being used by the user system and that the user's computer may contain software from a variety of vendors (e.g. *AT&T Tourguide Tutorial* from AT&T and *Word for Windows* from Microsoft, col 11, lines 34-40 and col 12, lines 24-42), thus it is implied that the information is provided to a vendor other than the vendor of the software product being used by the user. Furthermore, Fawcett discloses a similar system and method for monitoring and updating the software on a user system in which the tracking information is provided to a vendor server (update service center) which contains information about a wide variety of products to include "new computer software, new versions of existing computer software, new help files, etc." and "the availability of agent help files, wizards, inference engine, and other operating system components" (col 2, lines 30-45; col 5, lines 29-47; and col 6, lines 17-32) and that this update service center may be connected to a remote network or remote sites to allow "the update service center to provide a wider variety of computer software than could be stored at the update service center" (col 5, lines 10-16). Thus, the update service center contains a wide variety of software files/products, not necessarily from the same software developer. The Examiner notes that it would be unusual for a computer system to contain only software from one vendor. While a large vendor, such as Microsoft, may provide a wide variety of software products, their products are not all-inclusive. There are hundreds, if not

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thousands, of software providers which provide software for specific applications such as word processing, internet connection, spreadsheets, games, graphics, digital image manipulation, etc. As Todd discloses, the user's computer contains software products from at least two vendors – Microsoft and AT&T. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the tracking information in Todd to such a central update service center which contains software products and files from vendors other than the vendor which developed the software application currently being tracked on the user's system. One would have been motivated to present this information to such a vendor which carries software products from more than one software developer (vendor) in order to increase the range of targeted advertisements being presented by Todd, giving the user a more comprehensive choice of upgrades, help files, wizards, and new or replacement software products.

Claim 2: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 1 above, and Todd further discloses means for the user to request new information about a product from the general management means (col 13, lines 45-49; col 14, lines 1-5; and col 14, lines 26-36).

Claim 3: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Todd further discloses the registration process being built into the software and automatically executed upon installation on the user's computer (col 6, lines 50-55 and col 11, lines 43-58).

Claim 4: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Todd further discloses:

- a. A personal identification number as part of the registration information (col 13, lines 45-49 and col 14, lines 25-35); and
- b. The type of requested information which is extracted by the general management means and transmitted to the user (col 13, lines 47-49; col 14, lines 1-5; and col 14, lines 26-36).

Claims 5 and 6: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Todd further discloses basing the automatic update of the software on the number of times the application had been accessed. Todd discloses a subscription-based service that analyzes license and maintenance agreements before updating the software (col 12, lines 58-65) and that usage data is being tracked (col 4, lines 31-34 and col 12, lines 30-65). This implies that the subscription is based on the usage of software (i.e. number of uses), probably also tied to a predetermined time period (i.e. 10 uses per month).

Claims 8, 14, 15, and 18-20: Todd and Fawcett disclose a system and method for registering and updating software on a remote computer as in Claim 2 above, and Todd further discloses multiple vendors (remote data sources)(col 13, lines 16-28) updating the product information database of the general management means by providing new information pertaining to the type of product as requested by the user (col 12, lines 21-29 and col 12, lines 49-65). Todd discloses that the data is being revised on the remote data source which is part of a network of processing systems (col 13, lines 16-19) and contains a library of revisions (col 14, lines 18-20). Todd's further disclosure that the user may be able to actually purchase the update/new software from the remote data source (col 12, lines 53-57) and that at least one of the remote data servers could be a central data source (col 14, lines 41-46), implies that the central data source is being updated by the other remote data sources (i.e. vendor/manufacturer). Since the new information provided to the user is based on the type of product requested by the user during the registration step above, it is inherent that the vendor sells products which may be of interest to the user.

(10) Response to Argument

(a) The Appellant states that the Todd reference "discloses a system which detects and avoid faults or conflicts stemming from hardware and software configurations in a computer system"; that a "database stores information from a number of vendors"; that "information (such as software fixes) is transmitted from the vendor to the database"; and that this "database allows 'a manufacturer to track how its customers are using their computers, giving the manufacturer specific access and

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insight to its customers' needs and allowing the manufacturer to target its customer base with appropriate advertising" (page 3). The Appellant further notes that the Examiner asserted that Todd's reference to the AT&T Tourguide Tutorial and Microsoft Word for Windows in the list of installed software "implied that the information is provided to a vendor other than the vendor of the software product being used by the user". The Appellant then argues that "the assignee of Todd et al was a division AT&T and thus, the AT&T Tourguide Tutorial was not from a vendor different from the manufacturer of the user's computer" and "that one of ordinary skill in the art would find no suggestion by Todd et al of transmitting user registration information to anyone other than the manufacturer of the user's computer" (page 4). The Appellant further argues that although Todd discloses "that the registration database manages warranty information on the software currently on the user's computer" there is no suggestion "that the 'warranty information' is for multiple vendors" or "includes anything from someone other than the manufacturer of the user's computer" (page 4). Initially, the Examiner agrees with the Appellant's reasoning above that if AT&T is the manufacturer of the user's computer then the AT&T Tourguide Tutorial is software from the "vendor" of the user's computer. However, the first line under the "Computer" heading at the bottom of column 6 lists the manufacturer of the computer as Dell Computer Corp., not AT&T. Furthermore, the list of "Software Installed" in column 11 lists Microsoft Word for Windows, "Manage Your Money", "WinFax Pro", "Excel", "Lotus Notes", "cc.Mail Remote", and Calendar Creator" software in addition to the "AT&T Tourguide Tutorial". These software products are not manufactured by either Dell nor AT&T, but are from

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different vendors such as Microsoft and Lotus. Todd further discloses that once this list of hardware and software components and configurations has been compiled for the user's computer system it may be transmitted to remote data sources which "preferable contains a database of software revisions that may be communicated to the computer system" (col 12, lines 2-3). Todd continues with two examples of how the remote data source uses this data. In the first example, the remote data source detects that the AT&T Tourguide Tutorial should be revised and can respond automatically (col 12, lines 21-29). In the second example, the remote data source detects that the computer system is using Word for Windows, version 6.0 and "may suggest that the user obtain an upgrade on the processor and memory" and that this suggestion may be based on usage pattern tracking which determines "the amount of time the user actually spends running Word of Windows 6.0, as opposed to other applications" (col 12, lines 30-49). Therefore, Todd discloses communicating the compiled configuration data to remote data sources to receive software updates and hardware update suggestions for installed hardware and software components from a plurality of hardware and software vendors (manufacturers). The Examiner notes that the remote data source also include a registration database which includes "warranty information that manages warranty information". This warranty information pertains to the user's complete computer system, which as described above, tracks the hardware and software installed thereon to determine if the user's computer system is "qualified to receive analysis and software revision" (col 12, lines 58-65). Thus, the warranty information is for multiple vendors (i.e. "from someone other than the manufacturer of the user's computer").

(b) The Appellant argues that the Fawcett reference does not disclose that the central update service center contains software products and files from vendors other than the vendor which developed the software application currently being tracked because the reference was “assigned to Microsoft which is well known for not offering other vendor’s software.” (pages 4 and 5). The Examiner notes that the rejection is not based on who owns the reference patent, but on what the reference discloses. In column 2 (lines 30-45), Fawcett explicitly states that “When a user accesses the remote update service, an update service computer conducts an automatic inventory of the computer software on the user computer”. The Examiner notes that Fawcett does not state that the inventory only consists of some of the computer software, such as only software from Microsoft, but that it is an inventory of all of the computer software on the user’s computer (col 7, lines 3-7). Fawcett continues that the collected information is compared to the remote update service’s databases of software revision, update, etc. “to identify software available from the remote update service that might be appropriate for installation on the user computer, (i.e. new computer software, new versions of existing computer software, patches or fixes for existing computer software, new help files, etc.).”. Fawcett also disclose that “the update service center may also be connected to a remote network (e.g. the Internet)”, which “allows the update service center to provide a wider variety of computer software than could be stored at the update service center” (col 5, lines 11-16). Therefore, the Examiner asserts that Fawcett does disclose that the central update service center offers software from other vendors (other than Microsoft, as per the Appellant’s arguments).

(c) The Appellant argues in reference to Claim 1 that the references do not teach that the user registration information and user status information is transmitted to a vendor of the software product and to another vendor that sells products that may be of interest to users of the particular software product (page 5). As discussed above, Todd discloses that the collected information is transmitted to remote data sources which use this information to automatically update the user's software product with the latest revisions and updates or to send targeted promotions about new software products or hardware update suggestions. Therefore, the information is not being sent only to the manufacturer of the user's computer, but also to remote data sources with updates, revisions, and promotions about installed or new software and hardware components.

(d) The Appellant argues in reference to Claims 10-13 and 16-20 (page 5) and Claims 14 and 15 (page 6) that similar limitations pertaining to transmitting the information to "a different vendor other than the software product's vendor" are also in these claims and should be allowed "for the reasons discussed above". The Examiner has addressed this argument in the preceding paragraphs. The Examiner notes that in both of the references a user's computer is being inventoried to determine the installed hardware and software. The inventory information is then transmitted to one or more remote data servers which use the information to determine what, if any, updates or revisions are needed and available; or what promotions for new or revised hardware or software should be suggested to the user. Neither of the references disclose that the software or hardware being updated, revised, or suggested is limited to only one

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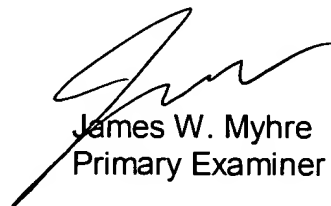
vendor's products. Therefore, such a limitation cannot be read into the references. In fact, based on the two disclosures it would have been obvious to one of ordinary skill in the art that the software being updated or revised is from a variety of vendors, such as Todd's disclosure of software from Microsoft, Lotus, and AT&T.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,





JWM
July 22, 2005



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